

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER FICKEISEN, MARTIN MEISTER, BERND RECK, DIETER URBAN,
ECKEHARDT WISTUBA, THOMAS KOCH, and GEORG LANGHAUSER

MAILED

JUN 24 2003

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-0248

Application No. 09/582,216

HEARD: May 20, 2003

Before GARRIS, PAK, and DELMENDO, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the Examiner to allow claims 9-35 as amended subsequent to the final rejection. These are all of the claims remaining in the application.

The subject matter on appeal relates to an aqueous composition comprising a polymer having a gel content of 5 to 40% by weight and a number-average molecular weight of a tetrahydofuran-soluble

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fraction of less than 30,000 and a filler selected from the group consisting of chalk and quartz flour.

Further details of this appealed subject matter are set forth in representative independent claim 9 which reads as follows:

9. An aqueous composition, comprising:

A) 10 to 50% by weight of a polymer having a gel content of 5 to 40% by weight and a number-average molecular weight, Mn, of a tetrahydrofuran-soluble fraction of less than 30,000; and

wherein said polymer comprises from 60 to 100% by weight of a C₁- to C₂₀-alkyl (meth)acrylate or mixture of at least two C₁- to C₂₀-alkyl (meth)acrylates, based on a total weight of said polymer; and

B) 50 to 90% by weight of a filler;

wherein the amount of said polymer and the amount of said filler are based on the weight sum of the polymer and of the filler; and

wherein said filler is selected from the group consisting of a chalk having an average particle diameter of from 2 to 50µm, a quartz flour having an average particle diameter of from 3 to 50µm and a combination thereof.

The references set forth below are relied upon by the Examiner in the rejections before us:

Kawashima et al. (Kawashima) 4,972,000 Nov. 20, 1990
(filed Feb. 24, 1989)

Fickeisen et al. (Fickeisen) 2,182,743 Aug. 17, 1995
(Canadian Patent Application)

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Claims 9-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Fickeisen.

Claims 9-14 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawashima in view of Fickeisen.

As correctly noted by the Examiner on page 3 of the answer, the appealed claims will stand or fall together, and the Appellants do not argue otherwise. Accordingly, in assessing the merits of the above noted rejections, we will focus on claim 9 which is the sole independent claim on appeal. See 37 CFR § 1.192(c)(7)(2001).

We refer to the brief and reply brief and to the answer for a complete discussion of the opposing viewpoints expressed by the Appellants and by the Examiner concerning these rejections.

OPINION

For the reasons which follow, we will sustain the Examiner's § 103 rejection but not her § 102 rejection.

We agree with the Appellants that Fickeisen fails to describe, within the meaning of § 102(b), a composition having the combination of features required by appealed independent claim 9 including the features of a gel content of 5 to 40% by weight, a number-average molecular weight of a tetrahydofuran-

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soluble fraction of less than 30,000 and the amount as well as type of a filler such as chalk. Indeed, the declaration filed February 15, 2002 under 37 CFR § 1.132 of record incontestably evinces that the exemplified polymers of Fickeisen do not possess the combination of gel content and number-average molecular weight features claimed by the Appellants. This deficiency of the here applied reference is fatal to the Examiner's § 102 rejection.

While we appreciate the Examiner's point that Fickeisen discloses each of the previously mentioned features, this alone is not enough to establish anticipation. For the Examiner's § 102 rejection to be proper, the Fickeisen reference must clearly and unequivocally disclose the here claimed composition or direct those skilled in the art to this composition without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the reference. In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Here, the appealed claim 9 composition would be obtained only by selectively picking, choosing and combining the various Fickeisen disclosures which satisfy the gel content, number-average molecular weight and filler requirements of

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claim 9 while selectively ignoring the disclosures of Fickeisen which do not satisfy these claim requirements.

The need for such picking, choosing and combining of disclosures from the Fickeisen reference is well evinced by the above discussed § 1.132 declaration of record. This declaration plainly reveals that the polymers which Fickeisen himself selected from his broad teachings and exemplified in the reference do not possess the combined features of gel content and number-average molecular weight required by the independent claim on appeal. Thus, it is beyond dispute that the Fickeisen reference does not anticipate the appealed claims under § 102 since it does not clearly and unequivocally disclose the here claimed composition without any need for picking, choosing and combining the various disclosures of the reference. Id.

For this reason, we cannot sustain the Examiner's § 102(b) rejection of all appealed claims as being anticipated by Fickeisen¹.

¹ Upon return of this application to the jurisdiction of the Examining Corps, the Examiner should consider the propriety of rejecting the appealed claims under 35 U.S.C. § 103(a) as being unpatentable over Fickeisen. In this regard, it is appropriate to clarify that we are here simply reversing a § 102 rejection based on anticipation and that it may well be a § 103 rejection
(continued...)

Concerning the § 103 rejection before us, the Examiner finds that Kawashima fails to disclose the appealed claim 9 requirement concerning a filler such as chalk but concludes that it would have been obvious for one with ordinary skill in the art to provide the composition of Kawashima with a chalk filler of the type and for the reasons taught by Fickeisen. This obviousness conclusion appears to be well taken particularly since Kawashima expressly discloses providing his composition with inorganic fillers that include calcium carbonate which is the compound constituting chalk.

Concerning this rejection, the Appellants argue that "Kawashima et al fail to disclose or suggest the claimed fillers and their particle size" (brief, page 10) and that "[e]ven a combination of Kawashima et al with CA 2,182,743 does not result in a composition having the claimed combination of gel content, number-average molecular weight and amount/type of filler" (brief, pages 10-11). We cannot agree. As indicated above, Kawashima's disclosure of calcium carbonate would have suggested chalk and certainly the combined teachings of the applied

¹(...continued)
based on obviousness is proper. See In re Arkley, 455 F.2d at 589, 172 USPQ at 527 (CCPA 1972).

references would have suggested providing Kawashima's composition with chalk filler as required by appealed claim 9 for the reasons explained in the answer.

Finally, with respect to the § 103 rejection under review, the Appellants refer to "the superior properties of the claimed composition [which] have been discussed above" (brief, page 11). The properties in question are apparently those discussed on pages 8 and 9 of the brief and involve the wet bonding capacities shown in Table 3 on page 10 of the subject specification. According to the Appellants, this table illustrates that, "[e]ven though the molecular weight of the polymers of the Comparison Examples fall within the claimed range, a superior wet bonding capacity can only be achieved if also the gel content is within the claimed range" (brief, page 9). However, the showing in Table 3 of the subject specification and the Appellants' arguments with respect thereto are simply not relevant to the Examiner's § 103 rejection based on Kawashima in view of Fickeisen. This irrelevance is most immediately appreciated by reiterating the Examiner's finding, which the Appellants have not contested, that the polymers of Kawashima exhibit the here claimed gel content and molecular weight

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features said to be responsible for superior wet bonding capacity.

In light of the foregoing, we will sustain the Examiner's § 103 rejection of claims 9-14 and 20 as being unpatentable over Kawashima in view of Fickeisen.

The decision of the Examiner is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


BRADLEY R. GARRIS

Administrative Patent Judge)


CHUNG K. PAK)

Administrative Patent Judge)

) BOARD OF PATENT
APPEALS
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ROMULO H. DELMENDO)

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